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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,787	04/14/2004	Bradford D. Henry	63288-656	4669
20277	7590	02/02/2006		
MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096			EXAMINER TAWFIK, SAMEH	
			ART UNIT	PAPER NUMBER
			3721	
DATE MAILED: 02/02/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/823,787

Applicant(s)

HENRY ET AL.

Examiner

Sameh H. Tawfik

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-21 and 23-29 is/are pending in the application.
- 4a) Of the above claim(s) 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 23-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-21 and 23-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new added limitations to claims 1 and 21 “the bending member is configured to bend the open envelope about an axis that is substantially perpendicular to a joint between the flap and the open envelop.” is not clearly described anywhere in the filed specification as to the exact location of the bending member in respect to an axis of joint between the flap and the open envelope.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 9, 10, and 17-21 rejected under 35 U.S.C. 102(b) as being anticipated by Long et al. (5,457,941).

Long discloses a high-speed envelope transport and packing system comprising: a conveyor for conveying an open envelope having a flap (Fig. 1); packing station for inserting an object into the conveyed open envelope (Fig. 1); and a bending member disposed in the packing station (Figs. 1, 6B; via 50a, 50b, 52, and 53); wherein the bending member is configured to impart a bend in the conveyed open envelope by displacing a center portion of the conveyed open envelope relative to widthwise distal end portions of the conveyed open envelope (Fig. 6B) and to maintain a bend in a conveyed open envelope until the open envelope is gripped by a gripping device (Fig. 1 and column 4, lines 15-20) in such a manner as to provide access to an interior of the open envelope or until an object is at least partially inserted into an interior of the open envelope (Fig. 1); and the bending member is configured to bend the open envelope about an axis that is substantially perpendicular to a joint between the flap and the open envelope, see for example (Fig. 6B; via any joint point between the flap and the open envelope could be considered as perpendicular to the bending member).

Regarding claim 3: wherein the bending member comprises a rail disposed along a direction of conveyance of the open envelope (Fig. 1; via 53 and belts 50a, 50b, and 52 are equivalent to rails) in a position substantially corresponding to a center line of the conveyed open envelope with respect to a widthwise direction of the conveyed open envelope (Figs. 6A and 6B).

Regarding claims 9 and 10: wherein a height of the rail is less than about 5.0 mm and/or between about 1.25 mm and 1.75 mm., see for example (Figs. 1, 6A, and 6B).

Regarding claim 17: wherein the bending member comprises a channel disposed along a direction of conveyance of the open envelope in a position substantially corresponding to a

central region of the conveyed open envelope with respect to a widthwise direction of the conveyed open envelope (Figs. 1, 6A, and 6B; via the space between the belts).

Regarding claim 18: wherein a width of the channel is greater than about half of a width of the conveyed open envelope with respect to the widthwise direction of the conveyed envelope (Figs. 6A and 6B; via the space between the belts).

Regarding claim 19: wherein a width of the channel is greater than about three-quarters of a width of the conveyed open envelope with respect to the widthwise direction of the conveyed open envelope (Figs. 6A and 6B; via the space between the belts).

Regarding claim 20: wherein the bending member comprises paired channels disposed along a direction of conveyance of the open envelope in positions substantially equidistant to a center line of a conveyed open envelope with respect to a widthwise direction of the conveyed open envelope (Figs. 1, 6A, and 6B), and wherein the paired channels are disposed to receive widthwise ends of the conveyed open envelope.

Regarding claim 21: a bending member configured to bend a conveyed envelope about the z-axis during conveyance of the conveyed envelope to increase the moment of inertia of the conveyed envelope about the z-axis above a corresponding moment of inertia of the conveyed envelope in a flat state (Figs. 6A and 6B).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 15, 16, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Long et al. (5,457,941).

Long does not disclose that paired rails of bending member. However, long discloses one rail as bending member via 53.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Long's bending member by having two or more bending rails, in order to better guide the envelope along the feeding bath, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claims 15 and 16: Long discloses that a height of the rail is less than about 5.0 mm and/or between about 1.25 mm and 1.75 mm., see for example (Figs. 1, 6A, and 6B).

Claims 4-8, 12-14, and 24-28 rejected under 35 U.S.C. 103(a) as being unpatentable over Long et al. (5,457,941) in view of Haas et al. (4,798,040).

Long does not disclose that a plurality of arranged vacuum ports on the rail. However, Haas discloses similar envelope packing system comprising the use of plurality of vacuum ports (Fig. 7; via 650A-650D).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Long's bending member by using arranged vacuum means, as suggested by Haas, in order to control the conveying of the envelope.

Regarding claims 5 and 13: wherein the rail (53) disposed along a direction of conveyance of the open envelope is disposed proximal to a side of the conveyed open envelope having the flap (Fig. 1).

Regarding claims 6, 8, and 14: wherein a front edge of the rail, relative to the direction of conveyance of the open envelope, is chamfered or curved (Fig. 1; via the bending portion of 53).

Regarding claims 24-28: Long does not disclose that a vacuum plate provided in the packing station; wherein the vacuum plate is configured to bias an envelope and an envelope flap against the vacuum plate at least during insertion of an insert into the conveyed open envelope. However, Hass, discloses similar envelope packing system comprising a vacuum plate provided in the packing station with plurality of vacuum ports; wherein the vacuum plate is removably attached to the packing station and positioned within a central region of the packing station and configured to bias an envelope and an envelope flap against the vacuum plate at least during insertion of an insert into the conveyed open envelope (Figs. 1 and 7; via vacuum means 650A-650D).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Long's insertion station by using a vacuum plate provided in the packing station with plurality of vacuum ports; wherein the vacuum plate is removably attached to the packing station and positioned within a central region of the packing station and configured to bias an envelope and an envelope flap against the vacuum plate at least during insertion of an insert into the conveyed open envelope, as suggested by Haas, in order to control the conveying of the envelope.

Response to Arguments

Applicant's arguments filed 12/06/2005 have been fully considered but they are not persuasive.

Applicants argue at the end of page 10 and top of page 11 of the arguments that applicants traverse the examiner statement as applicants did not distinctly and specifically point out the error in the June 28, 2005 restriction requirement, but rather applicants previously responded with traversed the restriction requirement with detailed reasoning and requested reconsideration of the restriction requirement. The examiner agrees with the applicants that proper response and arguments were filed along with the traversed election, but the examiner also believes that such filed arguments filed along with the election of paper No. 01222005 is not persuasive as applicants argued that independent claim 1 does in fact require the particular of independent claim 29 as a bending member is disclosed which is configured to control a bend in the open envelope so as to provide access to the interior of the open envelope or until an object is at least partially inserted therein; accordingly, inventions I and II are not distinct from each other. The examiner believes that independent claim 29 is in title of 112 6th “means for controlling a flap of each of the continuously conveyed open envelops”, which discloses all the futures for controlling the flap as disclosed on the filed specification or equivalent, which is different than independent claim 1.

Applicants further argue in pages 12 and 13 that Long’s reference does not disclose the amended claims 1 and 21 as the bending member is configured to bend the open envelope about an axis that is substantially perpendicular to a joint between the flap and the open envelope, in contrast, Long discloses an envelope stuffing device with feed belts used to bend the envelope along its length about an axis that is parallel to the joint between the flap and the envelope. The examiner believes that as the new added limitations to claims 1 and 21 are not positively cited in the claims, as applicants use “about” and “substantially” in the added limitations. Moreover, the

Art Unit: 3721

examiner believes that such limitations are disclosed in the applied reference of Long, as in Fig. 6B of Long discloses the bending member via 52 is configured to bend the open envelope 14 about an axis that is substantially perpendicular to a joint between the flap and the open envelope via the axis perpendicular to any joint point between the flap and the envelope.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

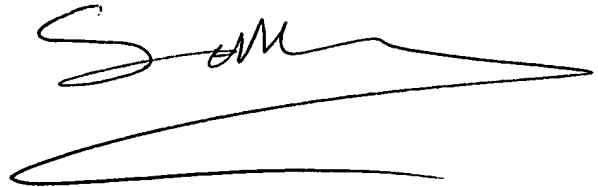
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sameh H. Tawfik whose telephone number is 571-272-4470. The examiner can normally be reached on Tuesday - Friday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3721

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sameh H. Tawfik
Patent Examiner
Art Unit 3721

A handwritten signature in black ink, appearing to read 'Sameh H. Tawfik', with a long horizontal flourish extending to the right.

ST.